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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/907,635	08/08/1997	MIYUKI ENOKIDA	35.C10457CON	8513

7590 04/07/2004

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NEW YORK, NY 101123801

EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

58

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/907,635

Applicant(s)

ENOKIDA ET AL.

Examiner

Stephen S. Hong

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 87-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 87-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Part III DETAILED ACTION**

1. This action is responsive to communications: amendment filed on November 26, 2003 to the RCE on June 12, 2003 to the application filed 8/8/97, which is a FWC of the application Ser. No. 09/378,819, filed 1/27/95.
2. Claims 87, 92, 93 and 98 are independent claims.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

- I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.
4. Claims 87-89, 92-95 and 98 remain rejected under 35 U.S.C. 102(e) as being anticipated by Bonomi, U.S. Pat. No. 5,577,191, 11/96 (filed 2/94).

As per independent claims 87, 92 and 98, Bonomi discloses the following claimed elements of a moving image editing apparatus:

- input means and decoding means for decoding encoded moving image data encoded by an encoding method that includes encoding using interframe correlation to an intraframe encoded moving image (col.2, line 54, "The video compression circuit

...compress the video data ...using both interframe and intraframe algorithm ...[and the video decompression circuit decompresses intraframe-only compressed video data to allow editing");

- encoding means for intraframe coding the decoded moving image data and storing the intraframe encoded image data (col.4, line 25, "...in FIG.2, intraframe-only compressed video data is retrieved from storage" shows that the data have been stored.);

- editing means for decoding the image data which was stored in said storing means and intraframe encoded, and for performing an arbitrary editing on the encoded image data (col.2, line 57, "intraframe-only compressed video data ...allow video editing to occur in the host processor."); and

- second encoding means for encoding the edited image data by an encoded method that includes encoding in which the interframe correlation is considered (col.2, line 59, "When the video editing is complete, the video ....the video compression circuit to compress the video data using both intraframe and interframe algorithm.").

Bonomi further discloses displaying the decoded image data (col.3, line 52, "...decompressed the video data to display the video images on display").

As per dependent claims 88, Bonomi teaches encoding the images in MPEG, which contains the predetermined number of intra-coded pictures (see col.1, lines 25+, "the standard is the MPEG...") and JPEG (col.1, lines 40-45).

As per dependent claims 89, Bonomi teaches designating a picture for editing (col.3, lines 1-10).

Claims 93-95 recite substantially similar limitations as claims 87-89, respectively, and are similarly rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 90-91 and 96-97 remain rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Nguyen, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92).

As per dependent claims 90-91, Bonomi teaches the editing features of insertion and deletion of number of pictures. However, Nguyen discloses animation images displayed in multi-screen displays that are obtained by reducing the frame images (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Bonomi, since Nguyen taught the specific features of editing animation frames, and

Bonomi explicitly suggested performing animation frame editions (col.1, line 52, "editing activities include special effects ..."). Nevertheless, Bonomi teaches the editing activities including "mixing, fades and wipes" (col.1, line 52), which require manipulating the number of pictures. Therefore, the features would have been obvious to a person of ordinary skill in the art at the time the invention was made in view of Bonomi's suggestions.

Claims 96-97 recite substantially similar limitations as claims 90-91, respectively, and are similarly rejected under the same rationale.

### ***Response to Arguments***

Applicant's arguments filed 11/26/2003 have been fully considered but they are not persuasive.

In the argument, Applicant asserts that :

In response to these rejections, Applicants respectfully wish to revisit the issue of whether Bonomi qualifies as prior art. As previously discussed, Applicants' Japanese priority document 6-010083 (JP'083), was filed on January 31, 1994, and thus predates Bonomi. In the Office Action mailed December 31, 2001, it was asserted that the JP '083 priority document fails to provide adequate support for Applicants' claimed invention, and in particular the "inter-picture" coding picture of the claims (see pages 6 and 7 of Office Action).

It is respectfully submitted, however, that the claims have been subsequently amended and no longer recite the first and second encoding steps of performing inter-picture coding. In Claim 87, for example, intra-picture coding is performed in the first and second encoding steps to the moving image data. Moreover, although Claim 87 still recites inputting image data using intra-picture coding and inter-picture coding, such encoding method, per se, are known in the art, and disclosure of "inter-picture" coding in, for example, paragraph 8 and 41 of the JP '083 priority document is more than sufficient to meet the requirements of 35 U.S.C. 112. The fact that the second Japanese priority document, i.e., Japanese priority document 7-007389 (which does not predate Bonomi) may provide more disclosure regarding "inter-picture" coding that the JP '083 does not take away from Applicants' assertion that JP '083 provides adequate support for the inputting of moving image data using intra-picture coding and inter-picture coding.

In response to the argument, Examiner disagrees that the earlier filed priority document JP '083 provides the adequate support for the claimed invention. First, the Applicant's assertion that "Claim 87 still recites inputting image data using intra-picture coding and inter-picture coding, such encoding method, per se, are known in the art" is not persuasive, since the question must be whether or not it was known at the time of the Applicant's invention. Examiner agrees that it is well known now. However, Examiner does not agree that it was known at the time of the invention. What was known is, as the JP '083 points out, that the MPEG coding technique, which used both intracoding and intercoding technique to create a compressed video sequence. This does not enable the claimed technique which calls for "decoding the moving image data input in said input step..[and] performing the intra-picture coding to the moving image data decoded in said first decoding step and storing the encoded data in a recoding medium. (see steps "b" and "c" of claim 87). Referring to page 8 of JP '083 document, it states that:

First, when the animating image coding data which is inputted and encoded by the MPEG system is designated from the user by using a pointing device such as a mouse ....., the designate animating image coding data is sequentially decoded by the MPEG decoder...[and] an output result is inputted to the JPEG encoder.

Note that in nowhere does it teach how the MPEG encoded picture is decoded to arrive at the "intraframe coded" image, which is selected by the user. Of course, it also does not teach that the "interframe" coded images are decoded and encoded. Since the MPEG coded images contain both intraframe and interframe coded images, the arbitrary selection of the image by the user would select either one of the intraframe and interframe coded images. Therefore, even if (for the argument sake) it is assumed that both interframe and intraframe coded images are decoded and re-encoded to the

intraframe scheme, the JP'083 document does not teach how the user selected image is isolated and then re-encoded into the intraframe coded image. Therefore, JP '083 can not possibly be relied upon to provide the support for the claimed invention.

Compare now to the JP'389 document, it teaches converting the interframe coded images in MPEG video to the intraframe coded scheme and it teaches how the conversion takes place: by identifying the I, P, and B frames for conversion (page 16, in the second paragraph). Therefore, the priority date for the claimed invention is January 20, 1995, since the claimed matter is disclosed and enabled only in the later JP'389 priority document.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark  
"EXPEDITED PROCEDURE")

Or:

(703) 305-9724 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

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Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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Art Unit: 2178

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A handwritten signature in black ink, appearing to read 'Stephen Hong', with a stylized, cursive script.

Stephen Hong

Primary Examiner

April 5, 2004